

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

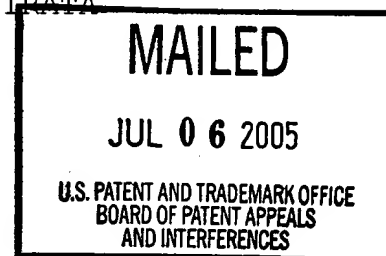
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Ex parte HIDEFUMI FUJIMOTO,  
KAZUO TAKAHASHI, KOJI TAKEDA, KEISUKE TANAKA,  
ETSUO OGINO, KENJI MORI and MASAHIRO HIRATA

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Application No. 09/857,382

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was received at the Board of Patent Appeals and Interferences on April 26, 2005. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

In response to the Final Rejection, mailed November 26, 2002, Appellant filed a Notice of Appeal, dated

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June 2, 2003, followed by an Appeal Brief filed on August 1, 2003. In response to Appellant's Appeal Brief, an Examiner's Answer was mailed August 26, 2003. The Examiner's Answer included the following prior art:

GREENBURG      6,027,766      FEB. 22, 2000

This reference was cited for the first time in the Examiner's Answer to show the state of the art, however, this reference may constitute the introduction of a new ground of rejection. See MPEP 1208.01.

Section 1208.01 of the Manual of Patent Examining Procedure (MPEP) (8th ed., Aug. 2001) states:

37 CFR § 1.193(a)(2) prohibits the entry of a new ground of rejection in an examiner's answer. At the time of preparing the answer to an appeal brief, however, the examiner may decide that he or she should apply a new ground of rejection against some or all of the appealed claims. In such an instance where a new ground of rejection is necessary, the examiner should reopen prosecution. The examiner must obtain supervisory approval in order to reopen prosecution after an appeal. See MPEP § 1002.02(d).

Accordingly, it is

**ORDERED** that the application is returned to the examiner for

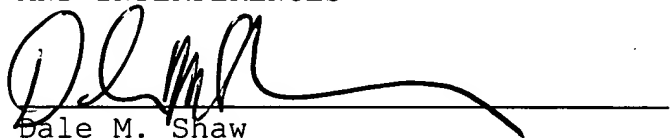
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resolution of the following issues:

- 1) vacate the Examiner's Answer, send out a new Examiner's Answer, excluding the Greenberg (6,027,766) reference; or
- 2) reopen prosecution to include the new ground of rejection; and
- 3) Any further action as deemed appropriate.

It is important that the Board of Patent Appeals and Interferences be informed promptly of any action affecting the appeal (i.e., abandonment, issue, reopening prosecution).

BOARD OF PATENT APPEALS  
AND INTERFERENCES



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Application No. 09/857,382

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